

REMARKS

This Preliminary Amendment as well as the previous Request for Reconsideration filed on May 5, 2008 constitute the proper Submission with the RCE being concurrently filed and fully complies with M.P.E.P. § 706.07(h)(II). This Preliminary Amendment addresses the Examiner's comments from the Advisory Action of May 21, 2008, as well as those comments from the Examiner during the recent Interview.

A Petition for Extension of Time is being concurrently filed with this Preliminary Response. Thus, this Preliminary Amendment is being timely filed.

Status of Claims

In the present Preliminary Amendment, claims 29-30 have been added. This makes claims 1, 2, 6, 7, 11, 13, 14, 16, 17, 19, 20, 22-24 and 28-30 as pending in the above-identified application.

No new matter has been added with the addition of claims 29 and 30. Support for these new claims is found in paragraphs [0062] and [0063], respectively, of US 2006/0102306 A1 (the publication of this application).

In view of the following remarks, Applicant respectfully requests that the Examiner withdraw all rejections and allow the currently pending claims.

Substance of the Interview

Applicant thanks Examiner D. Cordray for his time, helpfulness and courtesies extended to Applicant's representative during the Interview of June 3, 2008. The assistance of the

Examiner in advancing prosecution of the present application is greatly appreciated. In compliance with M.P.E.P. § 713.04, Applicant submits the following remarks.

The Interview Summary form amply summarizes the discussions at the Interview. Various ways of addressing the prior art rejections were discussed, and suggestions were discussed that may advance prosecution of this application.

Also during the Interview, the Examiner inquired into the support for the recent claim amendment that refers to the addition of surfactant (B) to an aqueous solution having copolymer (A). As also explained in the previous Request for Reconsideration of May 5, Applicant respectfully refers the Examiner to at least paragraph [0125] of US 2006/0102306 A1 (the publication of this application), which is a part of the disclosure of the tested Examples. Further, Applicants note paragraphs [0077]-[0081] and [0116]-[0123]. For instance, paragraph [0116] of the '306 published specification refers to how a polymer having a weight-average MW of 140,000 was obtained.

Issues under 35 U.S.C. § 112, First Paragraph

Claims 26 and 27 stand rejected under 35 U.S.C. § 112, first paragraph for asserted lack of written description (see Office Action at pages 3-4). The Advisory Action of May 21, 2008 indicates that this rejection has been overcome. Withdrawal of this rejection is respectfully requested.

Issues under 35 U.S.C. § 112, Second Paragraph

Claims 1, 2, 6, 7, 11-14, 16-20, 22-24, 26 and 27 stand rejected under 35 U.S.C. § 112, second paragraph for asserted lack of definiteness (see Office Action at pages 4-5). It appears that the Advisory Action of May 21, 2008 indicates that this rejection has been overcome. Thus, withdrawal of this rejection is respectfully requested. If not, Applicant respectfully requests consideration of the remarks set forth in the previous Request for Reconsideration of May 5, 2008. Again, the papermaking step is further defined by paragraph [0106] of the present specification. Further, based upon a closer reading of the present specification, it is clear that the paper quality improver is added before the step of making the paper, and the invention will thus work. The number of possible locations when adding components (A) and (B) are not so great as stated in the Office Action.

Issues under 35 U.S.C. § 103(a)

Claims 1, 2, 6, 7, 11-14, 14, 16-20, 22-24, 26 and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over **Zhang *et al.* '268** (U.S. Patent No. 6,417,268) in view of Fallon '380 (U.S. Patent No. 5,571,380) as evidenced by **Biale '096** (U.S. Patent No. 3,714,096), **Xiao *et al.* '392** (US 5,747,392) and **Smook** (*Handbook for Pulp and Paper Technologists*) (see pages 5-10 and 2-3 of the outstanding Office Action). Reconsideration and withdrawal of this rejection are respectfully requested based on the following considerations.

Previously Submitted Request for Reconsideration and the Recent Interview

This rejection was addressed in Applicant's Request for Reconsideration filed on May 5, 2008. Also, the Interview Summary indicates that this rejection has been overcome.

If not, Applicant notes that the recent Advisory Action indicates that Applicant's amendments to the pending claims and thus the accompanying arguments have not been considered as the previous claim amendments were not technically entered and considered by the Examiner (see also Box 3 of the PTOL-303 form and "continuation of 3" at page 2 of the Advisory Action). As one instance of such a claim amendment, claims 1, 2 and 14 have been amended to recite: "wherein a mixture of the copolymer (A) and the surfactant (B) is prepared by adding surfactant (B) to an aqueous solution of copolymer (A)." As another example, recently added claim 28 has not been considered on the merits. Thus, consideration of the recent claim amendments is respectfully requested, as it is believed that this rejection has been overcome. Applicant adds the following remarks which are in response to the comments in the Advisory Action.

Applicant notes that many of the previously submitted arguments are with respect to the claims as amended. Thus, though the Advisory Action addresses most of Applicant's arguments, Applicant respectfully requests reconsideration of these arguments in view of the now entered claim amendments.

Applicant also respectfully maintains his position as previously stated. For instance, Applicant respectfully submits that the citation of Fallon '380 does not properly account for such deficiencies of Zhang *et al.* '268 and is thus improper. As another instance, Fallon '380 does not disclose the instantly claimed amount of nonionic monomer having a solubility parameter of 20.5

(MPa)^{1/2} or less. Furthermore, it appears that the patentability of claim 13 has not been specifically analyzed, and only a textbook reference has been cited as accounting for the specific feature of this claim in combination with the base claim.

Polymer IV of Zhang *et al.* '268

Regarding the comments in the Advisory Action (at page 3) concerning the polymerization solutions of Polymer IV (not Polymer VI) of Examples 2 and 5 of Zhang *et al.* '268, Applicant notes that the A/B ratio still falls outside of what is being instantly claimed. In Polymer IV, 4.41g of surfactants was used for 59.611 of monomers. That means that A/B of Polymer IV is $59.611/4.41 = 93/7$, which is outside of the instantly claimed range of 85/15 to 15/85. It is believed that Zhang *et al.* '268 does not disclose the instantly claimed range of the A/B ratio.

Other Claimed Features

Applicant also notes that the present invention is directed to a process of making a pulp sheet, wherein the paper quality improver provides at least one paper quality improving effect of at least one of the following: the standard improved bulky value is 0.02 g/cm³ or more; the standard improved opacity is 1.0 point or more; and the standard improved brightness is 0.5 point or more. Applicant respectfully requests specific consideration of these recited features.

Summary

Thus, Applicant respectfully submits that the cited combination of Zhang *et al.* '268 and Fallon '380, as evidenced by Biale '096, Xiao *et al.* '392 and Smook is improper. A resolution of the *Graham* factors resides in Applicant's favor, and there is no reason or rationale for one of ordinary skill in the art to make the cited combination of references. For the reasons above and as previously stated in the May 5th Request for Reconsideration, and withdrawal of this rejection is respectfully requested.

Conclusion

In view of the above remarks and those of record, it is believed that claims are allowable. A Notice of Allowability is earnestly solicited. Favorable consideration of newly added claims 29 and 30 is also respectfully requested.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Eugene T. Perez (Reg. No. 48,501) at the telephone below to conduct an interview in an effort to expedite prosecution in connection with the present application.

Application No. 10/521,568

Art Unit 1791

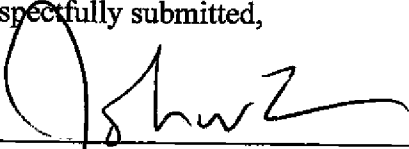
After Final Office Action of January 7, 2008

Docket No.: 0425-1171PUS1

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Dated: June 9, 2008

Respectfully submitted,

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